

REMARKS

In the Office Action dated September 25, 2003, the Examiner rejected claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Kumasawa et al. (U.S. Patent No. 6,101,574) in view of Sherman (U.S. Patent No. 6,141,765). The Examiner also objected to the Abstract as containing too many words, and objected to the Title as not descriptive.

By this Amendment, Applicants amend the Abstract and Title. In addition, claims 1-4 and 8-10 have been amended to improve form without changing their scope. In view of the following remarks, Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103(a), and objections to the abstract and title.

The Examiner objected to the Abstract for exceeding the 150-word limit. In response, Applicants have replaced the Abstract with one that conforms to the limit.

The Examiner objected to the Title as not descriptive. In response, Applicants amend the Title to be more descriptive.

With regard to the Examiner's rejection of claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Kumasawa et al. in view of Sherman, Applicants respectfully traverse that rejection, insofar as the Examiner may deem it applicable to the newly submitted claims, because a *prima facie* case of obviousness could not be made by the Examiner.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. (See M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

(See M.P.E.P. § 2143 (8th ed. 2001)). Third, a reasonable expectation of success must exist. Moreover, each of these requirement must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143.03 (8th ed. 2001)).

The elements of claim 1 are not taught or suggested by Kumasawa et al. in view of Sherman, contrary to the Examiner's allegations. Present claim 1 recites an information communication system for performing information communication between a first system and a second system, comprising: a first communication path that is used for information communication when a transfer size between the first system and the second system is smaller than a predetermined size and is capable of high-speed response when the transfer size is smaller than the predetermined size; and a second communication path that is used for information communication when the transfer size between the first system and the second system is larger than the predetermined size and has a larger transfer capability than that of said first communication path when the transfer size is larger than the predetermined size, wherein each of the first and second systems comprises main control means for selectively using one of said first and second communication paths in accordance with a size of information subjected to information communication with a counterpart system.

Applicants respectfully submit that Kumasawa et al. in view of Sherman do not disclose this claimed combination of elements. Among other things, the references do not disclose at least that "each of the first and second systems comprises main control means for selectively using one of said first and second communication paths in accordance with a size of information subjected to information communication with a counterpart system," as recited in claim 1.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Kumasawa et al. discloses a system including a disk control unit for writing and reading data to/from at least one disk device (Abstract). The disk control unit may comprise two disk control units which are connected to each other through a single bridge circuit 144 (see Fig. 2; col. 7, lines 10-33). In contrast, system consistent with the present claimed invention include both a first communication path and a second communication path connecting a first and second system that are selectively used in accordance with a size of information being communicated between the first and second systems.

Applicants submit that Kumasawa et al. does not selectively use a first and second communication path in accordance with the size of information being communicated. The Examiner admits as much in the rejection of claim 1. Specifically, the Examiner admitted that Kumasawa et al. fails to disclose "...wherein each of the first and second systems comprises main control means for selectively using one of said first and second communication paths in accordance with a size of information subjected to information communication with a counterpart system." Office Action, page 3. Accordingly, Kumasawa et al. does not disclose or suggest at least that "each of the first and second systems comprises main control means for selectively using one of said first and second communication paths in accordance with a size of information subjected to information communication with a counterpart system," as recited in claim 1.

Sherman fails to overcome the aforementioned deficiencies of Kumasawa et al. Sherman discloses a system in which a router may utilize a high speed bus (col. 12, lines 34-36). As noted by the Examiner, high speed bus 76 is divided into two separate

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

buses, 84 and 86, in order to provide two separate data and address paths to GDRam 80 and Gcam 82 (col. 12, line 67 - col. 13, line 3). GDRam 80 may serve as a fast access, large size data packet buffer for asynchronous transfer mode data packets (col. 13, lines 3-6).

In contrast, systems consistent with the present claimed invention selectively use a first and second communication path in accordance with the size of information being communicated. Sherman does not suggest that its buses are used dependent on the size of information being communicated. Buses 84 and 86 appear to simply be multiple buses that carry similar data, not communication paths that are used accordance with the size of information being communicated. Accordingly, Sherman either alone or in combination with Kumasawa et al., does not disclose, teach, or suggest at least that "each of the first and second systems comprises main control means for selectively using one of said first and second communication paths in accordance with a size of information subjected to information communication with a counterpart system," as recited in claim 1.

For at least the foregoing reasons, Applicants submit that claim 1 is patentable over Kumasawa et al. in view of Sherman. Because claim 5 is an independent claim with recitations similar to those of claim 1, Applicants further submit that claim 5 is patentable over Kumasawa et al. in view of Sherman for at least the reasons given with respect to claim 1.

The dependent claims 2-4 and 6-10 are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from Kumasawa et al. in view of Sherman.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Since each of the claims is allowable, Applicants respectfully request the timely allowance of this application.

If an extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Amendment, such extension is requested. If there are any other fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 20, 2004

By: 

Walter D. Davis, Jr.
Reg. No. 45,137

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com